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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,020	06/01/2005	Paolo Balliello	PL/2-22807/A/PCT	8510
324	7590	12/09/2008	EXAMINER	
JoAnn Villamizar			ABU ALI, SHUANGYI	
Ciba Corporation/Patent Department			ART UNIT	
540 White Plains Road			PAPER NUMBER	
P.O. Box 2005			1793	
Tarrytown, NY 10591			MAIL DATE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,020

Applicant(s)

BALLIELLO, PAOLO

Examiner

SHUANGYI ABU ALI

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/24/2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/24/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7, 9, 12-13, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent NO. 4,264,552 to McMahon et al, in combination with U.S. Patent No. 2,618,632 to Klug et al.

Regarding claims 1-5, 12 and 22, McMahon et al. disclose a composition comprising organic pigments, such as azo pigments and quinacridone pigments, and an additive system comprising a binder and an application agent. The binder can be cellulose derivatives or PVA. The application agents can be fatty acid, fatty alcohol and amines with 12-20 carbon atoms. The amount of the additive system is about 0.5-20% by weight based on the weight of the pigment. The amount of the binder based on the additive system can be about 5%. (col. 1, line 65 to col. 4, line 10 and examples)

But they are silent that the cellulose derivatives used in the composition has a substitution as applicant set forth in claim 1. However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to cellulose ethers with the DS as applicant set forth in claim 1, motivated by the fact that Klug, also drawn to cellulose derivatives being used as binder, disclose that such cellulose ether has good compatibility with various basic materials such as amines. (col. 7, lines 65-75)

Regarding claims 7, 13, 19 and 20-21, McMahon et al. disclose a method of preparing a composition comprising organic pigments, such as azo pigments and quinacridone pigments, and an additive system comprising a binder and an application agent in a water medium. The pigment to water amount can be overlaps with the ratio cited by the instant application. The Binder can be cellulose derivatives or PVA. The application agents can be fatty acid, fatty alcohol and amines with 12-20 carbon atoms.

The amount of the additive system is about 0.5-20% by weight based on the weight of the pigment. The amount of the binder based on the additive system can be about 5%.

But they are silent that the cellulose derivatives used in the composition having a substitution as applicant set forth in claim 7. However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to cellulose ethers with the DS as applicant set forth in claim 7, motivated by the fact that Klug, also drawn to cellulose derivatives being used as binder, disclose that such cellulose ether has good compatibility with various basic materials such as amines. (col. 7, lines 65-75)

Although they are silent the pH of process of making the composition. It is the position of the examiner that since the pH of the dispersion is determined by the constituents of the composition, the claimed dispersion pH would be inherent to that of teaching of McMahon et al. See MPEP 2112

Regarding claims 9, McMahon et al. disclose spray drying process is used to make the composition.

Claim 6, 11, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of Macmahon et al. and Klug et al. , further in view of U. S. patent No. 3,728,143 to Pollard et al.

Combined teaching of Macmahon et al. and Klug et al. disclose a method of incorporated binder treated pigments to plastic application. But they are silent the amount of pigment used in the plastic application.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use the pigment of combined teaching of Macmahon et al. and Klug et al. in the amount as applicant set forth in the instant application, motivated by the fact that Pollard et al., also drawn to pigmenting plastic, disclose that about 0.1 to 10 part of the pigment can be used to pigment 100 part polymer, such as polyolefin polymers. The commercial available Low density polyethylene has a molecular weight in the range of $5 \cdot 10^4$.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of Macmahon et al. and Klug et al. et al, further in view of U. S. patent No. 5,082,498 to Kurtz et al.

Regarding claim 8. combined teaching of Macmahon et al. and Klug et al. disclose a method of making pigment composition as applicant set forth in claim 7, However, they are silent about the pigment is a moist pigment cake state before added into the medium.

However, it would have been obvious to one of ordinary skill in the at the time of invention by applicant to added press cake pigment in the medium before spray drying process, motivated by the fact that Kurtz et al., also drawn to pigment preparation, disclose that press cake pigment is used in conventional spray drying process. (col. 4, lines 30-35).

The declaration under 37 CFR 1.132 filed 09/24/2008 is insufficient to overcome the rejection of claims based upon the unexpected result as set forth in the last Office action because: The data provided are not commensurate in scope with the broadly claimed invention. Claim 1 recites that the pigment is in the range of 92-97% and the binder is in the range of 3-8% based on the composition. The binder composition comprises a cellulose component in the range of 5-60% and a second component in the range of 10-95%. The declaration filed by the applicant only present one example, which has a binder composition comprise 4.5% of tallow alkyl amine and 0.5% of methyl cellulose, based on the pigment. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside (i.e. as well as the upper and lower limits) the claimed range to show the criticality of the claimed range. *In re Hill* 284 F.2d 955, 128 USPQ 197 (CCPA 1960).

Response to Arguments

Applicant's arguments with respect to claims 1-6 and 11-18 regarding GB 1,176,217 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Pollard disclose the amount of additive used is higher than the instant application. The Examiner respectfully submits that Pollard is used to show that pigment can be used to color polymer. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Macmahon et al. teaches the less binder is desirable, but there is no suggestion that the preparation of the instant application and the Examiner is conclusion is based on the hindsight reasoning. The Examiner respectfully submits that the Macmahon et al. clearly disclose that less binder is preferred for the reason of the cost. A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit 1793

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